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10/032,045	12/21/2001	William E. Simpson	9257/1	5126

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EXAMINER
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SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/032,045

Applicant(s)

SIMPSON, WILLIAM E.

Examiner

Gautam Sain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**1-1) Claims 1, 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes et al (US 6732087, filed Oct 1, 1999).**

**Regarding claim 1**, Hughes teaches “a server ... via client ... providers, ... service” (ie., users via internet can connect to server with storage with documents that users exchange with other users)(col 3, lines 39-60; col 2, lines 30-63; fig 1).

Hughes teaches a first user interface ... information (ie., users can select to add document to storage and can request to view data, users have “Add Document” and “Search Document” features)(col 3, lines 39-67; fig 1, items 5, 10, 15).

Hughes teaches a second user interface ... business information (ie., the administrator receives the contributed document from user, stores the document on the storage)(col 3, line 60 – col 4, line 15).

Hughes teaches a database of business information (ie., user selects a database for legal stuff)(col 4, lines 15-25, lines 45-50).

Hughes teaches business information ... documents (ie., users connect via Internet to servers to contribute and obtain documents)(col 3, lines 39-50; fig 1).

**Regarding claim 2**, Hughes teaches business information transmitted by second user (ie., multiple users store documents that multiple users query and retrieve)(col 2, lines 30-58).

***Claim Rejections - 35 USC § 103***

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2-1) Claims 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (as cited above), in view of the uslegalforms.com web site (Non Patent Literature, May 2000, see documents series labeled 1-8)(hereinafter "USLF").**

**Regarding claim 3**, Hughes teaches first control ... without cost (ie., users on the Internet communicate on web – without cost).

Hughes does not expressly teach, but USLF teaches web page listing business information (ie., a web page that allows users to download business legal forms; all users can be on a web page)(USLF document 1).

Hughes teaches second control ... for a fee (ie., user is prompted for payment for a document that was created/edited by another user)(col 4, line 65 – col 5, line 10).

Hughes teaches third control ... document (ie., a user can transmit a query to the system (step 405) ... user can fill in search criteria in the field)(col 4, lines 36-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web pages for downloading business legal forms as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 4**, Hughes teaches providing a web site ... edits business information (ie., users via internet can connect to server with storage with documents that users exchange with other users)(col 3, lines 39-60; col 2, lines 30-63; fig 1)(ie., users can select to add document to storage and can request to view data, users have “Add Document” and “Search Document” features)(col 3, lines 39-67; fig 1, items 5, 10, 15) (ie., the administrator receives the contributed document from user, stores the document on the storage)(col 3, line 60 – col 4, line 15).

Hughes teaches receiving ... transfer services (ie., user can select particular database in which to have search performed)(col 4, lines 45-50).

Hughes does not expressly teach but USLF teaches transmitting ... information user (ie., user registers to be able to download legal forms from a web site)(USFL document 1 and 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include registering a user to be able to download legal forms from a web site as taught by USLF, providing the benefit of providing thousands

of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 5**, Hughes does not expressly teach, but USLF teaches web page ... user without cost (ie., free legal forms listed – Tax forms)(document 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include free legal forms listed as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 6**, Hughes does not expressly teach, but USLF teaches receiving ... without cost (ie., user can click on any of the tax forms for free and download ... coupled with the teaching in Hughes that users selects)(col 4, line 47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include free tax forms listed and download them as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 7**, Hughes does not expressly teach, but USLF teaches transmitting ... conditions (ie., terms and conditions given to user prior to downloading – listed 1-11)(USLF, document 3; document 6, last page bottom).

Hughes does not expressly teach receiving ... said conditions (ie., user can click on the link “I agree to Register” on the last page of the agreement)(document 3).

Hughes does not expressly teach transmitting ... read only form (ie., fillable PDF file, user can fill but cannot save)(col 4, item #1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include terms and conditions where user can agree/disagree to accept the terms and download PDF files that do not save as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 8**, Hughes teaches ... for a fee (ie., user can download forms that other users contributed information for fee)(col 1, lines 63-65; col 3, lines 60-65).

Hughes does not expressly teach, but USLF teaches web page ... (document 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web pages as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 9**, Hughes teaches receiving ... for a fee (ie., user searches by query for documents contributed by other users, upon match, user can purchase document)(col 4, lines 36-67).

Hughes does not expressly teach, but USLF teaches web site ... (document 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web site as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 10**, Hughes teaches transmitting ... business information document (ie., search returns summaries for user to browse)(col 4, line 63).

Hughes teaches receiving at said ... document (ie., user is prompted for payment to purchase the selection upon answering the prompt, user's intention is captured and payment information is entered by the user)(col 4, line 65 – col 5, line 5).

Hughes does not expressly teach, but USLF teaches transmitting ... conditions (ie., terms and conditions given to user prior to downloading – listed 1-11)(USLF, document 3; document 6, last page bottom).

Hughes does not expressly teach receiving ... said conditions (ie., user can click on the link “I agree to Register” on the last page of the agreement)(document 3).

Hughes does not expressly teach transmitting ... read only form (ie., fillable PDF file, user can fill but cannot save)(col 4, item #1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include terms and conditions where user can agree/disagree to accept the terms and download PDF files that do not save as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 11**, Hughes teaches ... web site (ie., user can download forms that other users contributed information for fee)(col 1, lines 63-65; col 3, lines 60-65).

Hughes does not expressly teach, but USLF teaches web page ... (document 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web pages as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).



**Regarding claim 12**, Hughes teaches receiving ... for a fee (ie., user searches by query for documents contributed by other users, upon match, user can purchase document)(col 4, lines 36-67).

Hughes does not expressly teach, but USLF teaches web site ... (document 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web site as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 13**, Hughes does not expressly teach, but USLF teaches e) transmitting ... generated (ie., special categories search page – user can enter words to search in a category)(USFL, document 8).

Hughes does not expressly teach, but it would have been obvious with USLF teachings to receive ... selected class (ie., special categories search page – user can enter words to search in a category)(USFL, document 8).

Hughes teaches storing ... retrieval (ie., purchasing user's account ... )(col 5, lines 1-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web site with special categories with a search page that returns searched documents to the user as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 14**, Hughes teaches a) providing ... information (ie., users via internet can connect to server with storage with documents that users exchange with other users)(col 3, lines 39-60; col 2, lines 30-63; fig 1)(ie., users can select to add document to storage and can request to view data, users have “Add Document” and “Search Document” features)(col 3, lines 39-67; fig 1, items 5, 10, 15)(ie., the administrator receives the contributed document from user, stores the document on the storage)(col 3, line 60 – col 4, line 15).

Hughes teaches b) receiving ... provider (ie., upon receiving document by user – provider, unique number is assigned and associated with a name in a profile)(col 4, lines 8-20).

Hughes does not expressly teach, but USLF teaches c) transmitting ... form provider (ie., user fills out form on the web page and lists form needed where an attorney will contact the user)(document 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include web site where user fills out form on the web page and lists forms needed where an attorney can customize a form and contact the user as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 15**, Hughes teaches customized business ... business information (ie., user submits document along with profile that is subject to updates)(col 4, lines 1-25).

**Regarding claim 16**, Hughes teaches d) receiving ... provider (ie., profile of document provider with inputs from many parties received by administrator for the system)(col 4, lines 15-35).

Hughes teaches e) storing ... form provider (ie., the document contributed by users is stored at central repository)(col 4, lines 10-15). Hughes does not expressly teach, but USLF teaches ... read only document ... (ie., documents in pdf file formats)(document 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include read only documents for downloading as taught by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Regarding claim 17**, Hughes teaches transmitting ... form provider (ie., user can search his own queries and thereafter download them)(col 5, line 18-22).

Hughes teaches receiving ... document (ie., user can Add verdict summaries or related information and comments)(col 5, lines 30-40).

Hughes teaches f) storing ... form provider (ie., the document contributed by users is stored at central repository)(col 4, lines 10-15). Hughes does not expressly teach, but USLF teaches ... read only document ... (ie., documents in pdf file formats)(document 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include read only documents for downloading as taught

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by USLF, providing the benefit of providing thousands of forms available immediately from a web page on the client display (USLF, document 1).

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 703-305-8777. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703)305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

G.S.

GS

  
SANJIV SHAH  
PRIMARY EXAMINER